

### **REMARKS**

Claims 1-21 were previously pending in this application. Claim 2 has been amended to correct a misspelling and does not narrow the scope of the claim as pending. As a result, claims 1-21 are pending for examination with claims 1, 14, 20 and 21 being independent claims. No new matter has been added.

#### **Rejections Under 35 U.S.C. §112 First Paragraph**

Claims 1, 2, 5-12, and 14-21 stand rejected under 35 U.S.C. §112, first paragraph. The Office Action states that the limitations contained within these claims are broader in scope than the present disclosure of the invention. (See paragraph 4 of the Office Action mailed on July 23, 2003, "This limitation is deemed broader in scope than the present disclosure..." Also see paragraph 5, "These limitations are broader in scope than the disclosure of the invention..."). This rejection is respectfully traversed.

The appropriate test for determining whether a claim is enabled under §112, first paragraph is whether the scope of the enablement is commensurate with the scope of the claims. As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. MPEP §2164.01(b); *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

As stated in the Office Action, the specification discloses at least one method for making and using the claimed invention. Indeed, as discussed further below, it discloses a variety of methods and conditions and teaches the skilled practitioner how to select from such conditions or discover others, without undue experimentation, for practicing the invention. The issue, therefore, is whether the scope of the enablement bears a reasonable correlation to the scope of the claim. (See MPEP §2164.08, "All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further the scope of the enablement must only bear a 'reasonable correlation' to the scope of the claims." See e.g., *In re Fisher*, 427 F.2d 883, 839, 166 USPQ 18, 24 (CCPA 1970)). A claim is fully enabled if the specification provides enough guidance to one of ordinary skill in the art to make

and use the entire scope of the claimed invention without undue experimentation. (MPEP §2164.08).

As an initial matter, the focus of comparison in the Office Action, between the independent claims and the teaching in the specification in supporting the enablement rejection appears limited to a few specific limitations in the claims and not to the claims as a whole. This is incorrect. Claims 1, 14, 20 and 21 each recite a plurality of specific steps for forming a printed flocked pile fabric. All the steps of each claim must be considered together when determining how broad each claim is with respect to the disclosure to judge whether or not the claim is enabled. In paragraphs 4 and 5 of the Office Action, by contrast, the focus is on separate, disembodied limitations and the contention is that these limitations are broader than the disclosure. This, however, is not the relevant inquiry. Rather, the claims must be looked at as a whole as stated in the MPEP §2164.08, “The Examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually.” (Emphasis in original).

Contrary to what appears to be suggested in the Office Action, each of the methods of claims 1, 14, 20 and 21 does not cover “any and all conditions” for forming a printed flocked pile fabric in which fibers have been reoriented. Rather, the methods of claims 1, 14, 20 and 21 recite specific steps and limitations within those steps. For example, in claim 1, the step of washing the greige goods includes a limitation of washing at a temperature and for a time period under conditions sufficient to enable a liquid to which the greige goods are exposed to reorient fibers forming a flocked surface of the greige goods. Another step recites reorienting the fibers with the liquid. Some exemplary methods and conditions comprising examples of these steps and ways in which they may be practiced are presented in the disclosure (see, e.g. page 6 of the specification). Similarly, claims 14, 20 and 21 each recite specific steps of a method, and examples of those steps and ways in which they may be practiced are provided in the specification. Therefore, the above-mentioned first requirement that at least one method for making and using the claimed invention be disclosed is certainly satisfied for claims 1, 14, 20 and 21.

As noted above, a second requirement for enablement is that one skilled in the art be enabled, without undue experimentation, to make and use the entire scope of the claimed

invention. Even a single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements. The instant specification has provided a disclosure of a variety of conditions relevant to forming the claimed printed flocked pile fabric having reoriented fibers, as well as guidance as to how to select from such conditions and/or others to practice the claimed methods. As disclosed in the specification, these conditions may include, for example, the processing temperature and temperature cycling, the use of a desizing agent, the type of processing machine, the composition of washing liquor used during fiber reorientation, the tacking of the fabric into elongated tubes during the washing step and extraction step, the drying of the fabric in open-width form, etc.

In addition to the disclosure of a variety of conditions that may be adjusted, the specification clearly identifies characteristics of a suitable finished product produced as described in the methods as claimed. Examples of suitable characteristics for the finished product are provided on, for example, page 4, lines 1-8 and 11-22, and page 4, line 30 to page 5, line 12. Regarding independent claim 21, Applicants' specification clearly teaches, both in text and in figures, the difference between desirable hairlines and generally undesirable creases (see, e.g., Fig. 4; page 3, line 24; page 4, lines 23-25; and page 4, line 30 to page 5, line 12). Based on the disclosure in the specification of adjustable parameters, exemplified by the variety of disclosed operating conditions, and a manner of identifying suitable outcomes, one of skill in the art need not perform more than routine testing of these various selected conditions, or other conditions known in the art to have similar effect, to determine whether a specific set of selected conditions is suitable for performing the claimed methods. Accordingly, no undue experimentation would be required to practice the full scope of the claims.

It is not required to disclose every possible condition or combination of conditions for every possible type of flocked fabric that could be treated according to the claimed methods for the claimed methods to be enabled. Indeed, it would be impossible to meet such a standard, for the present claims, or any other claims for that matter. Such a standard of enablement would, in essence, restrict the scope of claims to the specific preferred examples disclosed in the specification. It is a fundamental tenet of black letter patent law that claim scope is not limited to the exemplary embodiments disclosed in the specification. In the present case, as pointed out on page 7 of the specification, for example, variations in fiber characteristics may change the

characteristics of the finished product, as may variations in other materials, such as the substrate, adhesives, etc. As would be readily appreciated by those skilled in the art, different types of flocked fabrics will have somewhat different sets of preferred conditions for reorienting fibers according to the claimed methods. The specification provides both specific examples of conditions and temperature ranges that have been found to work suitably with certain flocked fabrics as well as guidance in selecting suitable conditions for practicing the claimed methods on other flocked fabrics. The allowable scope of the claims should not be limited to the specific conditions or fabrics that the inventors have determined will work.<sup>1</sup> Given that it is believed that no undue experimentation would be required to practice the full scope of the rejected claims, the scope of enablement is believed to at least bear a reasonable correlation to the scope of the claims. Nothing more is required. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. §112, first paragraph of independent claims 1, 14, 20, and 21, and their respective dependent claims be withdrawn.

#### Rejections Under 35 U.S.C. §103

Claims 1, 2, 5-12, 14, and 17-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. 3,922,404 to Priester in view of EP 581 514 to McMulloch and claims 15, 16 and 20 over Priester and McMulloch in further view of U.S. 3,681,946 to Fleissner. As in the last Office Action, the present rejection of independent claims 1 and 14 relies, for its basis, on the contention that Priester teaches every limitation of the methods recited in these claims, except for printing the fabrics.

Regarding independent claim 1, in paragraph 10 of the Office Action, it is stated that Priester's step of dyeing or wetting the fabric will inherently reorient the fibers from an upstanding parallel position to an angular position in that any liquid flow will be 'sufficient conditions' to move the flock fibers into a new orientation, and that the reorientation from dyeing or wetting may or may not necessarily be a permanent reorientation.

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<sup>1</sup> [T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts. MPEP §2164.08; *In re Goffe* 542 F.2d 564, 567 (CCPA 1976).

Initially, it is pointed out that dependent claim 6 specifically claims removing the washed greige goods having random groups of fibers having angular and directional orientations that vary from one group to another from the wash chamber. As the Patent Office admits, any reorientation in Priester may or may not be permanent reorientation. As such, Priester cannot inherently disclose a step of removing from a wash chamber greiged goods having random groups of fibers having angular and directional orientations that vary from one group to another.

Regarding again independent claim 1, while the Priester method may involve temporarily reorienting fibers with a liquid (e.g. during the dying/wetting step), as is recited in claim 1, it does not necessarily follow that the fibers are reoriented into random groups, which random groups extend essentially uniformly across the entire width and along the length of the greige goods, the random groups of fibers having angular and directional orientations that vary from one group to another, as is further recited in claim 1. Even if the method of Priester may do so, which is not conceded, such a “chance” or even a likelihood does not satisfy the standard required to support inherency.<sup>2</sup> Indeed, as pointed out in previous responses to the Patent Office on this point, Priester clearly teaches that it his fabric crumpling/compression step, subsequent to his liquid contacting steps, that creates the inventive random fiber reorientation. On this basis alone, and without conceding that there would have been any motivation to combine Priester and McMulloch along the lines proposed by the Patent Office, the present rejection is insupportable. Accordingly, withdrawal of the rejections of independent claim 1 and dependent claims 2 and 5-12 on the present basis is respectfully requested.

Regarding independent claim 14, Priester does not appear to disclose or suggest any method including a step of removing from a wash chamber washed greige goods having random groups of fibers having angular and directional orientations that vary from one group to another, as recited in the removing step of claim 14. The Priester method, by contrast, teaches random reorientation of fibers during a step subsequent to wetting and/or dyeing of the fabric in a dye

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<sup>2</sup> To meet this burden, the Examiner must provide a rationale or evidence tending to show inherency. The fact that a certain characteristic may be present in the prior art is not sufficient to establish the inherency of that result or characteristic (see MPEP §2112). The limitation must necessarily be present in the teachings of the reference, such that it would be recognized as such by persons of ordinary skill in the art (MPEP §2112 and §3131, as recited in claim 14.01). Inherency may not be established by mere probabilities or possibilities (MPEP §2112). “In relying upon a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art” (MPEP §2112 quoting Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990)(emphasis in original)).

beck. Nowhere is it disclosed or suggested in Priester that the greiged goods undergo washing in a wash chamber under conditions sufficient to reorient the fibers forming a flocked surface of the greiged goods, such that upon removal of the washed greiged goods, the washed greiged goods would still be characterized by having random groups of fibers having angular and directional orientations that vary from one group to another, which random groups extending essentially uniformly across the entire width and along the length of the greige goods. Accordingly, withdrawal of the rejections of independent claim 14 and dependent claims 17-19 is respectfully requested.

Regarding independent claim 20, the Patent Office concedes that Priester does not teach forming greige goods into an elongated tubular shape, but asserts that it is well-known in the art that in piece or batch dyeing of fabrics in a beck dyeing machine, fabrics are formed into either a rope or tube shape. The Patent Office now points to Fleissner as teaching that a rope, a tube, and an open-width form are recognized equivalents in the art. In fact, Fleissner suggests that these fabric forms are not equivalents. For example, in column 2, lines 28-30, Fleissner states that an object of the invention is to provide a device which can handle the different forms of materials (ropes, tubes and open-width materials). According to Fleissner, prior art machines could be used with material tubes with a small diameter or thin long rolls, but not with flat materials. These teachings indicate that material tubes are not considered equivalents of flat materials.

Furthermore, the disclosure of Fleissner appears to equate the "material tubes" mentioned in column 2 specifically with tubular fabrics, such as tubular knit materials (col. 5, lines 21-25)<sup>3</sup> and not pile fabrics, such as utilized in the Priester method, or flocked pile fabrics as recited in claim 20, which have been formed into an elongated tubular shape, as is described only in the instant specification. Accordingly, Fleissner does not support the contention that elongated tubular shaped pile fabrics would have been recognized by those skilled in the art as one of several equivalent forms in which to process fabrics according to the Priester method. Moreover, even if Fleissner is combined with Priester, as suggested, nowhere does Fleissner appear to teach or suggest the step recited in claim 20 of opening the tubular greige goods into a non-

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<sup>3</sup> "Tubular fabric" is defined as "a fabric woven or knit in a tube form with no seams, such as a seamless pillowcase, some knit underwear fabrics, and seamless hosiery." (*Dictionary of Fiber & Textile Technology*, Hoechst Celanese Corporation Product/Technical Communications Services, Charlotte, NC, (1990). Clearly, a "tubular fabric", as defined, cannot be opened into a non-tubular shape without destroying the integrity of the desirable tubular structure of the fabric.

tubular shape. For the above-mentioned reasons, it is believed that the rejection of claim 20 has been traversed, and withdrawal of the rejection is respectfully requested.

**CONCLUSION**

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,  
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